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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,796	08/03/2004	Kevin Koch	43576.830008US1	4795
26582	7590	08/09/2006	EXAMINER	
HOLLAND & HART, LLP			SAIN, GAUTAM	
P.O BOX 8749			ART UNIT	
DENVER, CO 80201			PAPER NUMBER	
			2176	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/710,796

Applicant(s)

KOCH ET AL.

Examiner

Gautam Sain

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

- 1) This is the initial Non-Final rejection.
- 2) Effective filing date is 8/7/2003.
- 3) Claims 1-25 are pending.
- 4) Note: Regarding all claims, Applicant is requested to remove the brackets with the claim numbers (ie., [c1]).

Regarding claim 8, Applicant is requested to correct the grammar for the language "launching a viewer the provided means".

Regarding claim 18, Applicant is requested to properly number claim 18.

### ***Claim Rejections - 35 USC § 101***

- 5) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**5-1) Claims 1-16 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-16 and 25 sets forth non-functional descriptive material and fails to set forth physical structures or materials comprising of hardware or a combination of hardware and software within the technological arts (ie., a computer) to produce a "useful, concrete and tangible" result.

Specifically, the language such as "establishing an association" does not render the claimed invention as useful because the association can be a mental association. For example, if a transcript file has a witness name of "John Doe", and the exhibit file has a witness name of "John Doe", the association can be made mentally by associating the

witness, without any function performed by the processor and the same transcript and exhibit files can be written in the original form, with the witness association of John Doe, without any data manipulation, thus the processor servings as merely a pass-through means of data files without any function performed.

Thus, Claims 1-16 and 25 are interpreted as non-functional descriptive material without any useful result directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**6-1) Claims 1-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Przekop et al (US 200300789973, published Apr 24, 2003).**

**Regarding independent claim 1,** Przekop teaches providing electronic versions of transcripts with associated electronic versions of exhibits, the method performed on a processor comprising the steps of: importing one or more electronic transcript files and one or more electronic exhibit files to a publisher; establishing an association between at least one of the electronic transcript files and at least one of the electronic exhibit files; writing the one or more electronic transcript files and the one or more electronic exhibit files with the established association to at least one memory file; and providing a means to view the one or more electronic transcript files and the associated one or more electronic exhibit files. For example, Przekop discloses a web-enabled method

for distribution of transcript-synchronized video/audio recorder of legal proceedings to collaborative workgroups, where the server provides storage for video/audio records and corresponding transcripts (Abstract section). The server-side software synchronizes transcript and video/audio record so that each transcript line is synchronized to corresponding portion of the video/audio record, each transcript line containing a selectable link to the corresponding portion of the video/audio record (Abstract section; paragraph 11), providing the benefit of allowing a quicker comparison of a deponent's demeanor with the transcript (para 7). The examiner characterizes the claimed *exhibit file* to include video/audio files accessible by a viewer (see specification, paragraph 21), and equivalent to the video/audio files disclosed by Przekop (para 16).

**Regarding claim 2**, Przekop teaches writing to a portable media device. Przekop discloses downloading to a laptop (para 28).

**Regarding claim 3**, Przekop teaches portable media device comprises a magnetic disk, an optical disk, a tape, or a removable hard disk (para 28).

**Regarding claim 4**, Przekop teaches writing to a local memory file accessible from a local processor. For example, Przekop discloses the server automatically writing the files to a compact disk or desktop/laptop (para 28).

**Regarding claim 5**, Przekop teaches writing to a remote memory file accessible from a local processor. For example, Przekop discloses a connection between a client and server, where the transcripts can be saved to a removable storage medium (para 16).

**Regarding claim 6**, Przekop teaches wherein the remote memory is accessible through a network (paragraph 10, bottom "network such as the Internet").

Art Unit: 2176

**Regarding claim 7**, Przekop teaches wherein the network comprises at least one of a LAN, WAN, WLAN, Wi Fi network, Ethernet, Internet, World Wide Web, or an optical network (paragraph 10, bottom “network such as the Internet”).

**Regarding claim 8**, Przekop teaches establishing a network connection between the at least one memory file and a local processor; and launching a viewer the provided means to view at the local processor. Przekop discloses clients with web browsers for viewing the transcript and synchronize video/audio (para 13), distributed by the server on a connection between client and server (para 16).

**Regarding claim 9**, Przekop teaches the step of establishing an association comprises establishing a hyper-link from at least one of the one or more electronic transcripts to at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom).

**Regarding claim 10**, Przekop teaches the hyper-link is established at a first reference to the at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom). The examiner characterizes this limitation as a hyperlink established to reference an electronic exhibit.

**Regarding claim 11**, Przekop teaches the hyper-link is established at all references to the at least one of the one or more electronic exhibits. Przekop discloses a link in the

Art Unit: 2176

transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom). The examiner characterizes this limitation as a hyperlink established to reference an electronic exhibit.

**Regarding claim 12**, Przekop teaches the hyper-link is established at one or more user defined link points to the at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom), where the links are embedded in the transcript (para 11; para 24), embedded by a server.

**Regarding claim 13**, Przekop teaches a means to view step provides a means to view the electronic transcript and the associated electronic exhibit substantially simultaneously. Przekop discloses a multi-frame web browser with video image presented in a first frame 401 and the transcript presented in a second frame 402 (para 36; fig 4, items 401 and 402; para 42 "user wants to see text as well as video").

**Regarding claim 14**, Przekop teaches providing a means to view step further provides independent controls of the viewed electronic transcript and the associated electronic exhibit. Przekop discloses a multi-frame web browser with video image presented in a first frame 401 and the transcript presented in a second frame 402 (para 36; fig 4, items 401 and 402; para 42 "user wants to see text as well as video"). The examiner interprets each frame (401 and 402) as being independent because the user can search the text frame without any action on the video frame.

**Regarding claim 15**, Przekop teaches providing an interface to allow a user to select one or more electronic transcripts to view. For example, Przekop discloses allowing a user to read each transcript (para 30 and 31). If a user is granted access, someone must have selected which transcript the designated user is allowed to view.

**Regarding claim 16**, Przekop teaches means to view electronic exhibit files selected from a group of files consisting of: video, audio, video/audio, animation, MPEGS, still images, text files, TIF, PDF, JPG, bitmap, GIF format, and JPEGS (para 16).

**Regarding claim 17**, Przekop teaches an electronic transcript and at least one associated electronic exhibit, the computer usable medium comprising: an importing module configured to import one or more electronic transcript files and one or more electronic exhibit files; an association module configured to establish an electronic link between at least one of the one or more electronic transcript files and the one or more electronic exhibit files; a writing module configured to write the imported electronic transcript files and electronic exhibit files with the electronic link established by the association module to at least one memory file; and a viewing module configured to allow a user to view the at least one memory file. For example, Przekop discloses a web-enabled method for distribution of transcript-synchronized video/audio recorder of legal proceedings to collaborative workgroups, where the server provides storage for video/audio records and corresponding transcripts (Abstract section). The server-side software synchronizes transcript and video/audio record so that each transcript line is synchronized to corresponding portion of the video/audio record, each transcript line containing a selectable link to the corresponding portion of the video/audio record



Art Unit: 2176

(Abstract section; paragraph 11), providing the benefit of allowing a quicker comparison of a deponent's demeanor with the transcript (para 7). The examiner characterizes the claimed *exhibit file* to include video/audio files accessible by a viewer (see specification, paragraph 21), and equivalent to the video/audio files disclosed by Przekop (para 16). Additionally, the video can be imported to conventional litigation support software (para 28). The transcript file is converted to a .PDF and stored on a server along with the associated video/audio records (para 33), which the examiner equates to the claimed limitation of importing because storing a transcript on the server implies that the transcript was imported or copied onto the server and the conversion to PDF is the same as importing to a PDF. The user's can view the transcript and the associated video/audio in a browser (as shown in Fig 4; para 36), which is equivalent to the claimed viewing module.

**Regarding claim 18**, Przekop teaches a writing module is configured to write a file accessible over a network. For example, Przekop discloses saving records and transcripts to a storage medium across a connection between client and server (para 16).

**Regarding claim 19**, Przekop teaches the writing module is configured to write the at least one memory file to a medium selected from a group of medium consisting of: a magnetic disk, and optical disk, a tape, a removable hard disk, a CDROM, or a DVD disk (para 28). For example, Przekop discloses saving records and transcripts to a storage medium, across a connection between client and server, such as a compact disk (para 16).

**Regarding claim 20**, Przekop teaches the association module is configured to establish hyperlinks from the one or more electronic transcript files to the one or more electronic exhibit files. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom).

**Regarding claim 21**, Przekop teaches a viewing module is configured to view at least one of video, audio, video/audio, animation, MPEGs, still images, text files, TIF, PDF, JPG, bitmap, GIF format, and JPEGs (para 16).

**Regarding claim 22**, Przekop teaches the viewing module is configured to access the at least one memory file through a network connection (paragraph 10, bottom "network such as the Internet").

**Regarding claim 23**, Przekop teaches viewing module is configured to download the at least one memory file. Przekop discloses downloading the transcript and the video/audio record as a MPEG-1 file (para 36).

**Regarding claim 24**, Przekop teaches viewing module is configured to stream the at least one memory file. Przekop discloses transmitting the video/audio record as a scalable video stream (para 36).

**Regarding claim 25**, Przekop teaches a viewable electronic transcript and an associated electronic exhibit, the apparatus comprising: at least one memory file; and at least one processor, wherein the at least one memory file comprises: one or more electronic transcript files; one or more electronic exhibit files; and at least one

association file associating at least one of the one or more electronic transcript files and the one or more electronic exhibit files; the at least one processor comprises: a reader to read the at least one memory file; and a viewer to display the at least one memory file displayed, the viewer being configured to allow simultaneous display of the one or more electronic transcript and any associated electronic exhibits. For example, Przekop discloses a web-enabled method for distribution of transcript-synchronized video/audio recorder of legal proceedings to collaborative workgroups, where the server provides storage for video/audio records and corresponding transcripts (Abstract section). The server-side software synchronizes transcript and video/audio record so that each transcript line is synchronized to corresponding portion of the video/audio record, each transcript line containing a selectable link to the corresponding portion of the video/audio record (Abstract section; paragraph 11), providing the benefit of allowing a quicker comparison of a deponent's demeanor with the transcript (para 7). The examiner characterizes the claimed *exhibit file* to include video/audio files accessible by a viewer (see specification, paragraph 21), and equivalent to the video/audio files disclosed by Przekop (para 16). The user's can view the transcript and the associated video/audio in a browser (as shown in Fig 4; para 36). Przekop discloses a multi-frame web browser with video image presented in a first frame 401 and the transcript presented in a second frame 402 (para 36; fig 4, items 401 and 402; para 42 "user wants to see text as well as video"), which the examiner equates to the claimed "simultaneous display" because frames 401 and 402 are displayed at the same time.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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